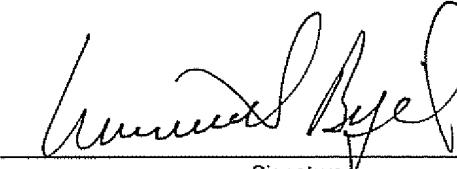


PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 9400-204 (030068)	
I hereby certify that this correspondence is being transmitted electronically to the U.S. Patent and Trademark Office on <u>June 28, 2006</u> Signature <u>Susan E. Freedman</u>		Application Number 09/608,184	Filed 06/30/2000
Typed or printed name <u>Susan E. Freedman</u>		First Named Inventor Samuel N. Zellner	Art Unit 2134
		Examiner Christopher J. Brown	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. <u>29,614</u> Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>		 Signature Mitchell S. Bigel Typed or printed name <u>919-854-1400</u> Telephone number <u>June 28, 2006</u> Date	
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

**RESPONSE UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2134**

Attorney Docket No. 9400-204 (030068)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Samuel N. Zellner

Confirmation No.: 9720

Serial No.: 09/608,184

Examiner: Christopher J. Brown

Filed: June 30, 2000

Group Art Unit: 2134

For: **SYSTEM AND METHOD FOR MONITORING COMMERCIAL TRANSACTION**

June 28, 2006

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**REASONS IN SUPPORT OF APPLICANT'S
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program.

It is not believed that an extension of time and/or any additional fee(s) are required beyond those that may otherwise be provided for in documents accompanying this paper. In the event, however, that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned under 37 C.F.R. §1.136(a). Any additional fees believed to be due in connection with this paper may be charged to our Deposit Account No. 50-0220.

REMARKS

Applicant hereby requests a Pre-Appeal Brief Review (hereinafter "Request") of Claims 56-65, which stand finally rejected under 35 USC §103(a) over U.S. Patent 5,708,422 to Blonder et al. in view of U.S. Patent 6,047,268 to Bartoli et al. Applicant respectfully submits that even if the references are combined, all of the claim recitations of the independent claims are not described or suggested, so that one or more elements needed for a *prima facie* rejection under 35 USC §103(a) are simply not present. Therefore, Applicant respectfully requests review of the present application by an appeal conference prior to filing of an Appeal Brief. In the interest of brevity, and without waiving the right to argue additional grounds should this Request be denied,

Applicant will merely point out the Examiner's omission of one or more essential elements needed for a *prima facie* rejection.

In particular, independent Claims 56, 60 and 62 all relate to a "commercial transaction processing center", which may be used, for example, to process credit card transactions. Each of these claims recites that the transaction processing center includes two systems: an authorization system and a monitoring system. The authorization system is configured to receive a request to authorize the commercial transaction, to determine whether or not the commercial transaction is authorized, and to send an authorization indicator to indicate whether or not the transaction is authorized. For example, accepting or denying a credit card charge request may be performed by the authorization system. The monitoring system, on the other hand, is configured to send a notification message of the commercial transaction to a payer of the commercial transaction substantially simultaneously with the sending of the authorization indicator by the authorization system. Thus, the monitoring system sends a notification message to the person who will be ultimately responsible for payment of the credit card bill. The authorization system has already determined whether or not the transaction is authorized, and has sent an authorization indicator, but the monitoring system simultaneously sends its own message to the person who is responsible for paying the credit card bill.

Claims 56, 60 and 62 elaborate on different aspects of the notification message that is sent by the monitoring system. In particular, Claim 56 states "the notification message including therein a help communication address for assistance with the commercial transaction". Claim 60 recites "the notification message including therein a communication address for reporting criminal activity that is related to the commercial transaction". Finally, Claim 62 recites "the notification message including therein identifying information related to the commercial transaction, and other information that may be desired by the payer that is independent of the commercial transaction". Thus, Claims 56, 60 and 62 have recognized that it may be beneficial to include various pieces of information in a notification message that is separate and apart from the credit card authorization system and its authorization indicator.

The primary reference Blonder et al. sets forth an elaborate system for both authorization and monitoring (referred to in Blonder et al. as "alerts"), including eight pages of detailed flowcharts. As part of monitoring, Blonder et al. describes in great detail messages that are sent to a card owner's pager as part of a monitoring process. In particular, Figure 4 of Blonder clearly illustrates that the message provides the cardholder's name 401, the credit card 402 and a field from Table 5 403. Figure 5 of Blonder illustrates three different fields: field 501 "CHARGING LIMIT EXCEEDED BY \$XXX.XX," field 502 "WAS USED FOR XX TRANSACTIONS

WITHIN 24 HOURS" and field 503 "WAS USED AT XXXX." Accordingly, Blonder is quite explicit as to what is displayed on the pager. What is not displayed on Blonder's pager is "a help communication address for assistance with a commercial transaction" as recited in Claim 56. What is also not displayed on Blonder et al.'s pager is a "communication address for reporting criminal activity that is related to the commercial transaction", as recited in Claim 60. Finally, what is also not displayed on Blonder et al.'s pager is "other information that may be desired by the payer that is independent of the commercial transaction", as recited in Claim 62.

In an unsuccessful attempt to supply the missing teachings, the final Official Action cites Bartoli et al. However, Bartoli et al. relates solely to an authorization system that allows transactions to be accomplished over the Internet utilizing a cookie. Bartoli et al. notes at Column 7, lines 28-32:

If authorization is denied, a message is displayed on the user's browser indicating that the purchase cannot be authorized and inviting the user to contact a customer assistance representative at a specified phone number. (Emphasis added.)

Similarly, Bartoli et al. Column 8, lines 52-54 state:

If not, at step B207, a message is sent back to the client terminal to inform the user at step C205 that they have not been authenticated and to call a customer assistance number. (Emphasis added.)

There is no motivation to combine Blonder et al. and Bartoli et al., because Blonder et al. provides eight pages of detailed flowcharts as to how authorization and monitoring take place. The only motivation to add features to Blonder et al. is by reading Claims 56, 60 and 62. Moreover, even if combined, Bartoli et al. would add a communication address to Blonder et al.'s authorization system, but would not change Blonder et al.'s monitoring system. Accordingly, even if there was some motivation to combine Bartoli et al. with Blonder et al., absent the hindsight provided by reading Applicant's claims, the combination simply would not describe or suggest the above-quoted recitations of the monitoring system of Claim 56, which provides a notification message including therein a help communication address. Moreover, the "notification message including therein a communication address for reporting criminal activity" of Claim 60 and the "notification message including...other information that may be desired by the payer that is independent of the commercial transaction" are not even described in Bartoli et al., so that, even if combined with Blonder et al., these recitations simply would not be described or suggested.

Applicant also wishes to note that dependent Claim 57 combines the recitations of Claims 60 and 56, dependent Claim 58 combines the recitations of Claims 62 and 56, dependent Claim

59 combines the recitations of Claims 56, 60 and 62, and dependent Claim 61 combines the recitations of independent Claims 60 and 62. These dependent claims are independently patentable because the claimed combinations of information in the notification message are certainly not described or suggested by the cited references.

Applicant would also like to briefly analyze the logic of the final rejection of Claims 56-65, found at Page 5 of the final Official Action. At the top of Page 5, the final Official Action agrees that "Blonder does not explicitly teach sending a contact help number with the page or message". However, the final Official Action predicates obviousness based upon the following logic:

It would have been obvious to one of ordinary skill in the art to combine the customer assistance phone number with the notification message of Blonder because a customer receiving the message by page would need to know where to call.

In response, Applicant notes that if Blonder et al. was combined with Bartoli et al., a customer assistance number would be provided in an authorization message because Bartoli et al. deals only with authorization. Moreover, the logic of "because a customer receiving the message by page would need to know where to call" would not apply to a notification message, where a transaction is already denied or approved. Indeed, if the customer is a thief or other unauthorized user, it may not be desirable to send a message to the customer. Only Claim 56 teaches that it may be desirable to send a notification message to the payer of the commercial transaction, which includes a help communication address.

As to Claim 57, the final Official Action's analysis states, at the bottom of Page 5:

As per claim 57, the Blonder-Bartoli combination teaches a customer assistance phone number which may be used to report criminal activity (Bartoli Col 7 lines 28-34).

However, to the extent Bartoli et al. teaches a customer assistance phone number which may be used to report criminal activity, this teaching is made as part of a transaction authorization process, and not as part of transaction monitoring.

Finally, at the bottom of Page 5, the final Official Action asserts that Blonder et al. teaches at Figure 5, **502**, a message containing information independent of the commercial transaction. However, Figure 5, **502**, is a message that the credit card "WAS USED FOR XX TRANSACTIONS WITHIN 25 HOURS" and Column 7, lines 49-53 of Blonder et al. state that:

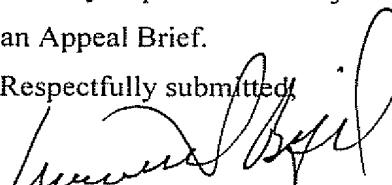
Similarly, when validation of a card number for a transaction would cause the maximum number of transactions per day pre-selected by the card owner to be exceeded, the content of the transaction counter field is moved into field **506**. (Emphasis added.)

This passage clearly includes the transaction in question, so that it is not independent of the commercial transaction. In view of the above, the detailed analysis provided at Page 5 of the final Official Action appears to be faulty.

In conclusion, Applicant wishes to note that prosecution of the present application has involved cancellation of original Claims 1-55 in view of the Examiner's excellent examination and citation of Blonder et al. and Bartoli et al. However, at this point, Applicant respectfully submits that Claims 56-65 have been drafted to patentably distinguish over the combination of Blonder et al. and Bartoli et al. unless they are impermissively combined based on the motivation provided by the claims, and Bartoli et al.'s clear discussion of the contents of an authorization message is impermissively applied to the claimed notification messages. Accordingly, one or more elements needed for a *prima facie* rejection under 35 USC §103(a) are simply not present.

Accordingly, for at least the reasons discussed above, the recitations of the claims are not described by the cited references, even if they are properly combinable (which they are not), so that one or more elements needed for a *prima facie* rejection under 35 USC §103(a) are simply not present. Therefore, Applicants respectfully request that the rejections be reversed by the appeal conference prior to the filing of an Appeal Brief.

Respectfully submitted,



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**CERTIFICATION OF ELECTRONIC TRANSMISSION
UNDER 37 CFR § 1.8**

I hereby certify that this correspondence is being transmitted electronically to the U.S. Patent and Trademark Office on June 28, 2006.



Susan E. Freedman
Date of Signature: June 28, 2006